

JMBMRef. 64743-5001

REMARKS

Claims 1-108 were examined and remain pending. The Examiner has maintained his rejection of all claims as unpatentable under either section 102(b) or 103(a), and has now added a rejection of certain dependent claims under Section 112, second paragraph, as detailed below. Each ground of rejection is addressed in turn. Applicant has added new claim 109.

I. Rejections under Section 112, Second Paragraph

The Examiner rejected claims 4-6, 30-32, 41-43, 60-62, 76-78, and 94-96 under Section 112, second paragraph, as indefinite. Applicant has amended claims 3, 29, 40, 75, 59, and 93 to provide adequate antecedent basis for the claim terminology thereby overcoming the rejection.

II. Rejections Under Section 102(b) Based on DeLorme

The Examiner rejected claims 1, 8, 9, 38, 46 and 47 under Section 102(b) as unpatentable over U.S. Patent No. 5,948,040 ("DeLorme"). (See Office Action dated 3/27/06 at pp. 3-4). Applicant has amended independent claims 1 and 38 to incorporate the limitations from claims 2 and 39, respectively, thereby overcoming the section 102 rejection. However, claims 2 and 39 stand rejected under section 103, and applicant will discuss the distinctions of the amended claims over the prior art below.

Claim 1 has been amended to read as follows:

- a. providing a database including travel information, weather information, traffic information, road construction information, terrorism information, legal information and suggested vaccinations pertaining to one or more geographic locations, wherein any of said information can be selectively retrieved from said database based on the geographic location to which it pertains;
- b. providing counseling services, wherein said providing counseling services comprises receiving information regarding said traveler's circumstances and geographic location, selecting information from said database based on said traveler's circumstances and geographic location, and providing said information to said traveler.

The Examiner has acknowledged that DeLorme fails to explicitly disclose each of the types of information previously recited in claims 2 and 39. (*Id.* at p. 4). These limitations have therefore

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now been incorporated into independent claims 1 and 38. However, the Examiner further states that "*these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The system/method . . . would be performed regardless of the type of travel services and travel service information provided to the user. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability*" (*Id.* at pp. 4-5). Applicant respectfully disagrees. The claimed database includes various types of information that are useful and valuable to the traveler, and despite the fact that DeLorme does disclose a wide variety of travel-related information, there is no hint or suggestion in DeLorme that weather information, traffic information, road construction information, terrorism information, legal information and suggested vaccinations would be useful information to include in such a database. Further, the fact that the database is explicitly limited by the claim to include the specific types of travel-related information enumerated is not irrelevant to patentability, as the Examiner states, but is in fact important in defining the structure of the database. Using the logic of the Examiner, the contents of any database would be irrelevant when considering patentability, and such a conclusion simply does not make sense. The claimed database has structural characteristics by virtue of the type of data stored therein.

On the basis of the foregoing, applicant submits that claim 1 as amended is patentable over the cited reference. Claims 8 and 9 are dependent from claim 1 and therefore patentable for the same reasons.

Applicant's independent claim 38 recites a two element system that corresponds directly to the two step method recited in claim 1, and which has been amended in the same manner as claim 1. Therefore, the arguments applicable to claim 1 are equally applicable to claim 38. For that reason, applicant submits that claim 38 is patentable over the cited reference. Further, claims 46 and 47 depend from claim 38 and are patentable for the same reasons.

III. Rejections Under Section 103(a) Based On DeLorme

The Examiner rejected claims 2-7, 11-13, 15-26, 29-37, 39-45, 49-51, 53-90, 93-101, and 104-106 under Section 103(a) as unpatentable over DeLorme. (*See* Office Action dated 3/27/06 at pp. 4-14).

Claims 2-7, 11-13, and 15-19 are dependent from claim 1, and are patentable for the same reasons as claim 1, discussed above.

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Independent claim 20 recites a two step method whereby in response to the traveler depressing a single button on his/her mobile phone, two things occur: a geographic location is transmitted, and a rescue service provider is dispatched to the geographic location. There is no intermediate step recited in the claims – the button is depressed, and the actions occur.

The Examiner acknowledges that DeLorme fails to disclose the step of providing the traveler with a mobile phone. (Office Action dated 3/27/2006 at p. 9). However, the Examiner goes on to state that it would be obvious to provide the user with a phone "*that would be compatible with the Trips system, in order to increase system effectiveness and customer service by providing users with the tools necessary to use the travel information software . . .*" (*Id.*) This conclusory allegation is without basis or merit, and applicant therefore submits that the Examiner has failed to make a *prima facie* case for obviousness. The claim as written requires not only a phone, but also a button that when depressed provides the two required actions. There is no suggestion or motivation, either in DeLorme or in the knowledge generally available to one skilled in the art, to modify DeLorme to provide single button that when depressed provides both required actions, i.e., transmitting the location of the traveler, and dispatching a rescue service provider the location. To reach this conclusion, the Examiner appears to have employed impermissible hindsight reasoning. Further, these claim limitations are not taught or suggested in DeLorme. There is simply no teaching or suggestion that depression of a single button on the phone would cause the traveler's location to be transmitted, and a rescue service provider to be immediately dispatched to the traveler's location.

To the contrary, DeLorme teaches away from this one step operation by describing a two step electronic dialog whereby the traveler pushes rescue button 916, then the TRIPS system responds with a menu of choices. The traveler then pushes the "+" or "-" button to select one of the choices. (DeLorme at col. 73:64 – 74:15). Thus, DeLorme does not provide teach or suggest the use of a single button to initiate two discrete actions, namely transmitting the location of the traveler, and dispatching a rescue service provider to the location. For these reasons, applicant submits that claim 20 as written is patentable over the cited reference.

Claims 21-26 and 29-37 depend from claim 20, and are patentable for the reasons discussed above.

Independent claim 84 is a two element system or apparatus claim that corresponds directly to the method of independent claim 20, and the arguments applicable to claim 20 are equally applicable to claim 84. For that reason, applicant submits that claim 84 is patentable over the cited

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reference. Further, claims 85-90 and 93-101 depend from claim 84, and are patentable for the same reasons.

Independent claim 104 is a two step method that also corresponds closely to the method of independent claim 20, except that instead of a mobile phone with a button that transmits a geographic location, claim 104 recites "a mobile communication device" that transmits a geographic location. The arguments applicable to claim 20 are equally applicable to claim 104. For that reason, applicant submits that claim 104 is patentable over the cited reference. Further, claims 105 and 106 depend from claim 104, and are patentable for the same reasons.

Independent claim 58 recites a three step method, including the step of providing a database of travel information including "weather information, traffic information, road construction information, terrorism information, legal information, and suggested vaccinations." The Examiner acknowledges that DeLorme fails to disclose these specific types of information. (*Id.* at page 9). However, the Examiner states that it would have been obvious "to incorporate a large variety of travel information with the system in order to increase the systems [sic] effectiveness at offering relevant customer information." (*Id.*) This conclusory allegation is without basis or merit, and is made with the benefit of hindsight. There is no teaching or suggestion anywhere in DeLorme to use or incorporate this type of information, and applicant submits that the Examiner has failed to establish a prima facie for obviousness. There is simply no suggestion or motivation within DeLorme to modify DeLorme to incorporate this type of information, even though, as the Examiner acknowledges, "DeLorme does disclose a multitude of travel information." (*Id.*) On that basis, applicant submits that the claim as pending is patentable over the cited reference.

Claims 59-67 depend from claim 58, and are patentable for the same reasons.

Independent claim 68 recites a two step method including the step of providing counseling services and providing information, wherein information is selected from the group consisting of, inter alia, weather information, traffic information, road construction information, terrorism information, legal information, and suggested vaccinations. As noted above with regard to claim 1, DeLorme does not teach or suggest providing these specific types of information. Therefore, for all the same reasons, applicant submits that claim 68 is patentable over the cited reference.

Claims 69-73 depend from claim 68, and are patentable for the same reasons.

Independent claim 74 is a three element system that corresponds directly to the method of independent claim 58, and the arguments applicable to claim 58 are equally applicable to claim 74.

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For that reason, applicant submits that claim 74 is patentable over the cited reference. Further, claims 75-83 depend from claim 74, and are patentable for the same reasons.

IV. Rejections Under Section 103(a) Based On DeLorme In View Of Marcon

The Examiner rejected claims 10, 14, 27, 28, 48, 52, 91, 92, 102, 103, 107, and 108 under Section 103(a) as unpatentable over DeLorme in view of U.S. Patent Publication No. 2001/0052142 ("Marcon"). (See Office Action dated 10/14/05 at page 11). Applicant traverses the rejection.

Claims 10 and 14 depend from claim 1, and are patentable for the same reasons described above. Claims 107 and 108 depend from claim 10, and are patentable for the same reasons.

Claims 27 and 28 are dependent from claim 20, and are patentable for the same reasons.

Claims 48 and 52 are dependent from claim 38, and are patentable for the same reasons.

Claims 91 and 92 are dependent from claim 84, and are patentable for the same reasons.

Independent claim 102 is a twelve step method that includes various steps already discussed. For example, claim 102 includes the step of providing a mobile phone whereby in response to the traveler depressing a single button on his/her mobile phone, the traveler's location is transmitted, and a rescue service provider is dispatched to the traveler's location. As noted with regard to claim 20, DeLorme does not teach or suggest such a step, and Marcon fails to supply the missing teaching. In addition, claim 102 includes the step of providing a database of travel information including "weather information, traffic information, road construction information, terrorism information, legal information, and suggested vaccinations." As noted with regard to claim 58, DeLorme does not teach or suggest such a step, and Marcon fails to supply the missing teaching. For at least the foregoing reasons, applicant submits that claim 102 is patentable over the cited combination.

Independent claim 103 is a ten element system that also recites various elements previously discussed, including a mobile phone including a button which, when depressed, transmits the traveler's location and dispatches a rescue service provider, and a database of travel information including "weather information, traffic information, road construction information, terrorism information, legal information, and suggested vaccinations." As discussed above, none of these elements is taught or suggested by DeLorme, and Marcon fails to supply the missing teaching. For at least those reasons, claim 103 is patentable over the cited combination.

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V. New Claim 109

Applicant has added new claim 109, which includes two structural elements: a database having specified types of information stored therein, and a mobile communications device configured with a special button that transmits the traveler's location as well as dispatching a rescue services provider to the traveler's location. Both of these limitations have been discussed extensively above, and for all the reasons discussed, applicant submits that these limitations render this new claim patentable over the cited art, either alone or in combination.

VI. Conclusion

In light of the foregoing, applicant submits that the claims as pending are patentable over the cited prior art, alone or in combination. The Examiner's favorable reconsideration is solicited.

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Respectfully submitted,

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